

Appl. No. 09/783,633
Amdt. Dated 25-Apr-05
Reply to Office Action of 12/23/2004
Attorney Docket No. : 6006-009

Argument

Claims 48-55 and 67 have been rejected under 35 U.S.C. §102(b) as being anticipated by Flomenblit ('641), while claims 48-67 have been rejected under 35 U.S.C. §102(b) as being anticipated by Burmeister, et al. (EP '730). Both Flomenblit and Burmeister references teach shape memory or superelastic stent devices which expand in response to being exposed to a given transition temperature. What is crucial to note is that in both references, it is the stent structural itself which is responding to the temperature condition, not a sensor element associated with the stent structural member as presently claimed.

Background of the Law

In order to establish proper anticipation under 35 U.S.C. §102, each and every element of the claimed invention must be disclosed in a single prior art reference. *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). The claimed elements either be inherent or disclosed expressly in the single prior art reference *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir. 1988) and must be arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989). The absence from the reference of any claimed element necessarily negates anticipation. *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 220 USPQ 81 (Fed. Cir. 1986).

Remarks

Applicant has amended the pending claims to further clarify in base claim 49 that that inventive device is comprised of "a plurality of structural elements capable of expanding within an anatomical passage way" with at least some of the structural elements "further comprising at least one sensor element that detects an energy stimulus ... and responds ... by altering the geometry of conformational profile of the device....." Thus, applicants' claims clarify that the sensor element is a separate element from the structural element. Since neither reference teaches, expressly or implicitly, a sensor device in which the sensor element is a separate element from the structural

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member, as presently claimed, the Examiner's reliance upon Flomenblit and Burmeiter to support the anticipation rejection is inappropriate.

The Examiner's Response to Applicant's prior arguments is noted, but in view of the foregoing amendments and argument, is deemed moot.

Applicant is in the process of obtaining a newly signed Declaration, and will timely file the same upon obtaining the inventor's signatures thereto.

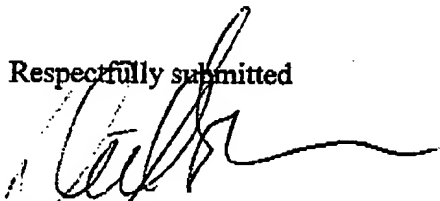
Summary

Accordingly, Applicant submits that the pending claims are patentably distinct from and over the art cited and of record. Favorable reconsideration of the rejection of the pending claims is solicited.

This Amendment is being concurrently filed with an Amendment Transmittal Letter including a fee calculation sheet, any applicable Request for Extension, and fee calculations. The Director is authorized to deduct any additional expenses from Deposit Account No. 18-2000, of which the undersigned is an authorized signatory.

Should the Examiner find that there are any outstanding matters which are susceptible of resolution by telephone interview, the Examiner is invited to telephone the undersigned to discuss the same.

Respectfully submitted



David G. Rosenbaum
Reg. No. 31,872

ROSENBAUM & ASSOCIATES, P.C.
650 Dundee Road, Suite 380
Northbrook, IL 60062
Tel. 847-770-6000
Fax. 847-770-6010
E-mail: drosenbaum@biopatentlaw.com